



Howrey Docket No.: 05742.0007.CPUS00

2013
164

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Adam Michael Fenne

Application No.: 09/428,395

Filed: October 28, 1999

For: **MATCHING OF A REDUCED SPECTRUM
LIGHTING SOURCE WITH VIDEO
ENCODING PROGRAM VARIABLES FOR
INCREASED DATA COMPRESSION
RATIOS**

Art Unit: 2613

Examiner: Howard W. Britton

**TRANSMITTAL OF REQUEST
FOR RECONSIDERATION OF DECISION DENYING
PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Petition to Withdraw Holding of Abandonment mailed August 19, 2004, Applicant submits the following documents for appropriate action by the U.S. Patent and Trademark Office:

- Request for Reconsideration of Decision Denying Petition to Withdraw Holding of Abandonment, including Exhibit 1 (6 pp.) and Exhibit 2 (4 pp.);
- Copy of Decision on Petition to Withdraw Holding of Abandonment; and

CERTIFICATE OF MAILING

(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached hereto) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to *Mail Stop Amendment*, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

October 18, 2004
Date of Deposit

Carol Fallon

Name of Person Mailing Paper

Signature of Person Mailing Paper

Return postcard.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment to our Deposit Account No. **08-3038**. Kindly make reference to Howrey Docket No. 05742.0007.CPUS00 when charging any fees.

If extensions of time under 37 C.F.R. § 1.136 other than those otherwise provided for herewith are required to prevent abandonment of the present patent application, then such extensions of time are hereby petitioned, and any fees therefor are hereby authorized to be charged to our Deposit Account No. **08-3038**.

Respectfully submitted,

Date: October 18, 2004

Sean Burdick
Sean D. Burdick, Reg. No. 51,513
PRACTITIONER

HOWREY SIMON ARNOLD & WHITE, LLP
2041 Fairview Park Drive, **Box No. 7**
Falls Church, VA 22042
FAX No. (703) 336-6950
Telephone No. (949) 759-5219



Howrey Docket No. 05742.0007.CPUS00

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Adam Michael Fenne

Application No.: 09/428,395

Filed: October 28, 1999

For: **MATCHING OF A REDUCED
SPECTRUM LIGHTING SOURCE WITH
VIDEO ENCODING PROGRAM
VARIABLES FOR INCREASED DATA
COMPRESSION RATIOS**

Art Unit: 2613

Examiner: Howard W. Britton

**REQUEST FOR RECONSIDERATION OF DECISION DENYING
PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests reconsideration of the decision mailed August 19, 2004 denying Applicant's Petition to Withdraw Holding of Abandonment ("Petition").

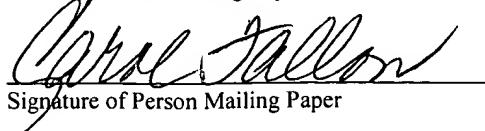
The Special Program Examiner denied the Petition because it was "not clear from the petition" that the statement required under MPEP § 711.03(c)(II)(b) could be attributed to the Practitioner, since there is a suggestion in the closing paragraph of the Petition that it is the Applicant (rather than the Practitioner) who attesting to the futile search of the file jacket and docket records.

CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached hereto) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

October 18, 2004
Date of Deposit

Carol Fallon
Name of Person Mailing Paper


Signature of Person Mailing Paper

In response, the undersigned Practitioner hereby affirms that in fact, the statement in the Petition required under MPEP § 711.03(c)(II)(b) was a statement made by the *Practitioner*. Moreover, it follows logically that the statement is attributable to the Practitioner because the Practitioner is the custodian of Applicant's file jacket and Practitioner's docket records, therefore the Practitioner is in the best position to review these files and affirm that the Notice of Allowance was never received.

BACKGROUND

On behalf of the Applicant, Practitioner recounts the following facts:

On December 19, 2002, Applicant timely filed a terminal disclaimer and response to an Office Action, mailed by the U.S. Patent and Trademark Office on October 3, 2002. A postcard was received from the U.S. Patent and Trademark Office on January 3, 2003, stamped December 27, 2002 by the P.T.O. See Exhibit 1, attached herein. Practitioner's docketing manager, Mr. Kory Mingus, entered the Office Action response and a status check for the patent application was noted in the docket for December 19, 2003. See Exhibit 2, attached herein. A one-year status check after the filing of a response is standard procedure for Practitioner's firm.

On June 2, 2003, at the request of the patent agent in charge of the application, Ms. Robin Clow of Practitioner's firm spoke with Examiner Britton regarding the status of the application. Examiner Britton notified her that the application was allowed and a Notice of Allowance was mailed on February 11, 2003. Ms. Clow immediately spoke to several individuals at the U.S. Patent and Trademark Office, and on June 13, 2003, Ms. Toni Hood in the Office of Publications faxed a Notice of Allowance to our office. A thorough search of the file jacket and docket sheet by the Practitioner uncovered no Notice of Allowance documents or entries. In addition, a search of Practitioner's computer databases by the Practitioner for documents routinely scanned upon receipt from the U.S. Patent and Trademark Office turned up no documents for the instant application during the relevant period of time.

In light of the foregoing remarks *made by the undersigned Practitioner*, Applicant and Practitioner believe that a good faith showing has been made that the office action was not received.

CONCLUSION

In conclusion, the undersigned Practitioner hereby unequivocally states that:

(a) the Notice of Allowance was not received by the Practitioner; and

(b) in fact, a search of the file jacket and docket records indicates that the Notice of

Allowance was not received during the relevant time period.

Based on the foregoing, Applicant and Practitioner request that upon reconsideration, the Petition be granted, the holding of abandonment be withdrawn, and the subject application be passed to issuance. A completed Issue Fee Transmittal and Issue Fee have been previously submitted with the Petition.

Applicant and Practitioner believe that under MPEP § 711.03(c), no additional fee is due for requesting reconsideration. However, if any such fee is required, the Commissioner is hereby authorized to charge the same to our Deposit Account No. **08-3038**. Kindly make reference to Howrey Docket No. 05742.0007.CPUS00 when debiting this fee.

Respectfully submitted,

Date: October 18, 2004

Sean D. Burdick
Sean D. Burdick, Reg. No. 51,513
PRACTITIONER

HOWREY SIMON ARNOLD & WHITE, LLP
2041 Fairview Park Drive, **Box No. 7**
Falls Church, VA 22042
FAX No. (703) 336-6950
Telephone No. (949) 759-5219



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POSTAGE WILL BE PAID BY ADDRESSEE

HOWREY SIMON ARNOLD & WHITE, LLP
301 RAVENSWOOD AVENUE
BOX 34
MENLO PARK, CA 94025

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JAN 03 2003

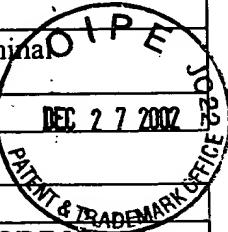
Howrey - SV



Please indicate receipt of the b-identified paper:

PTO

| | | |
|--|------------------------------|--|
| <input type="checkbox"/> New Application For: | Utility | Priority Date: |
| <input type="checkbox"/> Foreign priority already claimed | | Fee Amount: or any related fee not specified |
| <input type="checkbox"/> Continuation | <input type="checkbox"/> CIP | <input type="checkbox"/> Divisional CPA <input type="checkbox"/> |
| <input type="checkbox"/> Specification: | | <input type="checkbox"/> Drawings: |
| <input checked="" type="checkbox"/> Response to Office Action Dated: 10/3/02 | | <input type="checkbox"/> Final Rejection |
| <input checked="" type="checkbox"/> Other: Transmittal Letter (2 pages); Submission of Formal Drawings; Formal Drawings; Terminal Disclaimer; and postcard | | |
| <input type="checkbox"/> Assignment Enclosed | | <input type="checkbox"/> Cert. of Timely Mailing |
| | | <input type="checkbox"/> Exp. Mail: |



IDENTIFICATION OF APPLICATION

| | |
|---|----------------------------------|
| Serial No.: 09/428,395 | Responsible Attorney: RCL |
| Title: MATCHING OF A REDUCED SPECTRUM LIGHTING SOURCE WITH VIDEO ENCODING PROGRAM VARIABLES FOR INCREASED DATA COMPRESSION RATIOS | |
| Applicant: Adam Michael Fenne | Entered By: |
| Client: Pixelon.com, Inc. | Firm File No.: 05742.0007.CPUS00 |
| Mailed: 12/19/02 | Filed: 10/28/99 |
| Due Date: | |



Howrey Docket No. 05742.0007.CPUS00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Adam Michael Fenne

Application No.: 09/428,395

Filed: October 28, 1999

For: **MATCHING OF A REDUCED
SPECTRUM LIGHTING SOURCE
WITH VIDEO ENCODING PROGRAM
VARIABLES FOR INCREASED DATA
COMPRESSION RATIOS**

Art Unit: 2613

Examiner: Howard W. Britton

FILE COPY

TRANSMITTAL OF RESPONSE TO OFFICE ACTION

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Applicant submits the following documents for appropriate action by the U.S. Patent and Trademark Office:

- Response to Office Action;
- Submission of Formal Drawings;
- Formal Drawings;
- Terminal Disclaimer; and

CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached hereto) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

12/19 , 2002
Date of Deposit

Robin L. Clow

Name of Person Mailing Paper

R. Clow
Signature of Person Mailing Paper

Return postcard.

The U.S. Patent and Trademark Office is hereby authorized to charge \$55.00, and charge any fee deficiency or credit any overpayment, to our Deposit Account No. 08-3038, referencing Docket No. 05742.0007.CPUS00.

Respectfully submitted,


William C. Rookridge, Reg. No. 31,791

HOWREY SIMON ARNOLD & WHITE, LLP
Box No. 34
301 Ravenswood Avenue
Menlo Park, CA 94025
Facsimile: (650) 463-8400
Telephone: (949) 759-2904

EXHIBIT 1 p. 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Adam Michael Fenne

Serial No. 09/428,395

Filed: October 28, 1999

For: **MATCHING OF A REDUCED
SPECTRUM LIGHTING
SOURCE WITH VIDEO
ENCODING PROGRAM
VARIABLES FOR INCREASED
DATA COMPRESSION
RATIOS**

Group Art: 2613

Examiner: Howard W. Britton

RESPONSE TO OFFICE ACTION

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed October 3, 2002, kindly enter the following remarks:

REMARKS

Claims 1-13 are pending in the instant application. Claims 9-13 have been allowed. Claims 1-8 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 09/351,618 (now U.S. Patent No. 6,470,048). The drawings were objected to as being informal.

CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached hereto) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

12/19, 2002
Date of Deposit

Robin L. Clow
Name of Person Mailing Paper

R. Clow
Signature of Person Mailing Paper

All of the stated grounds of rejection have been rendered moot with the timely filing of a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). In addition, formal drawings in accordance with 37 C.F.R. § 1.84 are herewith submitted to overcome the objections to the drawings. As such, the instant application is in condition for allowance. Prompt and favorable consideration of this Response is respectfully requested.

The U.S. Patent and Trademark Office is hereby authorized to charge \$55.00 for the Terminal Disclaimer Fee under 37 C.F.R. § 1.20(d), and charge any fee deficiency or credit any overpayment, to our Deposit Account No. 08-3038, referencing Docket No.
05742.0007.CPUS00.

Respectfully submitted,



William C. Rookridge, Reg. No. 31, 791

HOWREY SIMON ARNOLD & WHITE, LLP
301 Ravenswood Avenue, Box No. 34
Menlo Park, CA 94025
FAX No. (650) 463-8400
Telephone No. (949) 759-3904

EXHIBIT 1, p.5

CASE RECORD LISTING

| | | | |
|---------------------------|--|------------------------|------------|
| File No | 05742.0007.CPUS00 | Status Code | PEN |
| Old Matter Number | | Country Code | US |
| Short Title | Matching of a Reduced Spectrum Lighting Source with Video Encoding Program Variables for Increased Data Compression Ratios | Case Type | CIP |
| Region | CALIFORNIA | Last Amended | |
| Location | IRVINE | Last Amended By | KMINGUS |
| Defendant (Opps) | | Entity Size Ind | Small |
| Opposer (Opps) | | CPA Reportable | Y |
| Language of Filing | | Module | Patents |

| <u>Base Reference</u> | <u>Date</u> | <u>Number</u> |
|--------------------------------|-------------|---------------|
| Application No. / Date | 28 Oct 1999 | 09/428,395 |
| Grant / Issue No. / Date | | |
| Publication (early) | | |
| Publication (post-examination) | | |

| <u>Role Type</u> | <u>Name</u> |
|----------------------|---------------------------------------|
| Inventor | Fenne Adam Michael |
| Client | Pixelon.com, a California corporation |
| Billing Attorney | Rookridge William C. |
| Responsible Attorney | Rookridge William C. |
| Action Person | Westin Lori P. |

CASE RECORD LISTING

| <u>Diary Due Dates</u> | <u>Action</u> | <u>Comments</u> | <u>Completed Date</u> |
|------------------------|-------------------------------|--|-----------------------|
| 6/1/2003 | Status of Filing Receipt | (orig d/l 5/5/02) Filing Receipt missing from transferred file; 8/20/02 - sent Client further req for power to obtain copy; 10/22/02 - spoke to Client remd of Filing Receipt inst-client wil confer to determine costs; per RClow's 4/29/03 email inst - move 06/02/03 - per RClow talked w/Exam Britton - case allowed in February - Notice of Allowance sent on 2/11/03 & published 4/25/03 | |
| 12/19/2003 | Status Office Action | | |
| 1/28/2000 | Status of Missing Parts | | 12/1/1999 |
| 1/26/2000 | Response to Missing Parts Due | | 1/20/2000 |
| 6/20/2002 | Status of Revocation/POA | 12/20/01 - filed Rev/POA & Change of Correspondence Address; 01/07/02 - rec'd Return Rev/POA Postcard date-stamped 12/20/01; 02/05/02 - rec'd Notice Re POA dated 1/7/02 - POA accepted | 2/5/2002 |
| 7/13/2002 | Status of Assignment Recordal | Pixelon to Dante due to a bankruptcy procedure re-submitted February 27, 2002 by Joel Voelzke; 05/10/02 - dtd Notice of Recordation rec'd. | 5/10/2002 |
| 10/1/2002 | Status of Patent Application | 04/01/02 - left mess. w/ Ex. req. status of app.; 04/02/02 - Ex. left mess. con. that there are no outstanding OA (no action yet), Ex. says it will be 3-6 m. before OA is ready to be sent; | 10/9/2002 |
| 1/9/2003 | Status Check | | 10/9/2002 |
| 1/3/2003 | Response to OA | 10/09/02 - rec'd 3M Non-Final Office Action dtd 10/3; 10/11/02 - sent Client copy of OA & req inst by 11/15/02; per LPW's 11/18 dkt - rec'd Client inst to file terminal disclaimer; 12/19/02 - filed Resp to OA; 12/19/02 - sent Client copy of Resp filed | 12/19/2002 |
| 2/3/2003 | Response to OA Extension 1 | 01/03/03 - rec'd Return Postcard dtd 12/27/02 | 12/19/2002 |
| 3/3/2003 | Response to OA Extension 2 | | 12/19/2002 |
| 4/3/2003 | Response to OA Final Deadline | | 12/19/2002 |

CASE RECORD LISTING**Abstract****Remarks**

Client No.: 17954-22
Examiner: George Bugg (703-305-2329)

12/20/01 - filed Rev/POA & Change of Correspondence Address; 01/07/02 - rec'd Return Rev/POA Postcard date-stamped 12/20/01; 02/04/02 - rec'd Notice of Non-Recordation dated 01/25/02 - 2-sided pgs not acceptable (Assignment from Pixelon to Dante re Bankruptcy sale also for 3NPUS00, 4NPUS00, 5NPUS00, 6CPUS01, 7CPUS00, 8CPUS00, 9CPUS00 & 09/351,028 - see 0006NPUS00 for docketing); 02/12/02 - rec'd Notice of Recordation dtd 1/26/02 - Reel/Frame: 012336/0853, Recordation Date: 12/03/01, Dante Pugliese to Pixelon.com, Inc.; per K. Cheatham - POA was rec'd and is in file;

Assignment Info (Bankruptcy Sale)
Reel/Frame: 012675/0337
Assignor: Pixelon, Inc.
Assignee: Dante Pugliese
Recordation Date: 02/27/02

Claims**Date Docketed:** 02 Jun 2003**DOCKETED BY:** _____**CHECKED BY:** _____

EXHIBIT 2, p.3



UNITED STATES PATENT AND TRADEMARK OFFICE



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AUG 23 2004

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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HOWREY - SV
PATENT DOCKETING

Paper No. 16

William C. Rookridge
Howrey Simon Arnold & White LLP
301 Ravenswood Avenue Box No 34
Menlo Park CA 94025

In re Application of
Adam Michael Fenne
Application No. 09/428,395
Filed: October 28, 1999
For: MATCHING A REDUCED SPECTRUM
LIGHTING SOURCE WITH VIDEO ENCODING
PROGRAM VARIABLES FOR INCREASED
DATA COMPRESSION RATIOS

MAIL

AUG 19 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

This is a decision on the Petition to Withdraw Holding of Abandonment which is treated as pursuant to 37 C.F.R. §1.181, filed June 26, 2003 and resubmitted on September 29, 2003 and again on April 13, 2004. No fee is required.

The petition is **DENIED**.

This application became abandoned due to failure to pay the issue fee in response to the Notice of Allowance and Issue Fee Due mailed February 11, 2003. A Notice of Abandonment was mailed on June 19, 2003.

Petitioner has alleged non-receipt of the Notice of Allowance and Issue Fee Due. In the petition, the petitioner has provided a statement that the Notice was not received by the petitioner and a copy of the docket record where the non-received Office action would have been entered had it been received and docketed.

MPEP § 711.03(c) Petitions Relating to Abandonment, states in part:...

II. PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that:

- (a) the Office communication was not received by the practitioner;
- (b) attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.

Moreover, a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached and referenced in practitioner's statement.

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HOWREY SIMON ARNOLD & WHITE, LLP

AUG 24 2004
WASHINGTON, D.C.
DOCKETED *JME*
8/27/04

As mentioned, Petitioner states that the Notice of Allowance and Issue Fee Due was not received and also references a docket log within their petition. Moreover, the petition does state "A thorough search of the file jacket and docket sheet uncovered no notice of allowance documents or entries", however, it is not clear from the petition if this is a statement from the Practitioner or the Applicant. The following paragraph of the petition states "...Applicant believes that he has made a good faith showing that the office action was not received." This tends to suggest that the Applicant is making the statement in the previous paragraph and thus does not comply with the requirements of a successful petition to withdraw the holding of abandonment due to the lack of a statement from the Practitioner attesting to a personal search of the file jacket and docket records and indicating that the office communication was not received.

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision and include the statement from the Practitioner as outlined above.

The file is being forwarded to the file repository.



Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications